

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Charles Edward ANDERSON, IV

Application No. 10/080,671

Filed: February 25, 2002

For: **System, Method And Computer
Program Product For Selectively
Caching Domain Name System
Information On A Network Gateway**

Confirmation No. 8173

Art Unit: 2441

Examiner: Chirag R. PATEL

Atty. Docket: 1875.1990000

Reply Brief Under 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents

Commissioner for Patents
PO Box 1450
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Sir:

Appellant hereby files one copy of this Reply Brief ("Reply Brief") responsive to the Examiner's Answer mailed on August 4, 2008 ("Examiner's Answer"). The Examiner's Answer was responsive to Appellant's Brief on Appeal Under 37 C.F.R. § 41.37 filed on April 22, 2009 ("Appeal Brief"). The Appeal Brief was itself responsive to the non-final Office Action of January 22, 2009 ("Office Action"). Appellant found standing to bring the Appeal from the Office Action under M.P.E.P. § 1207.04, as prosecution was reopened prior to a decision on the merits by the Board.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 19-0036.

A. *Rejection of claims 1-9, 22-29, 39-45, 48, and 50 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,041,360 to Himmel et al.*

The Examiner has maintained a rejection of claims 1-9, 22-29, 39-45, 48, and 50 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,041,360 to Himmel et al. ("Himmel"). Appellant respectfully maintains the Appeal.

1. *The claimed subject matter provides frequently accessed domain names for caching at a network gateway*

Independent claims 1, 22, and 39 are directed to a method operable at customer premises equipment for identifying and providing frequently accessed domain names "to a network gateway for use in domain name system caching." In other words, frequently accessed domain names are stored at a network gateway instead of being stored only at the customer premises equipment (as is conventionally done). The independent claims 1, 22 and 39 all recite identifying the frequently accessed domain names and providing the domain names to a communication interface for transmission to the network gateway.

Himmel is entirely different. Himmel is directed to bookmarks in a web browser which are updated when the page data for a corresponding bookmark changes. (Himmel, Abstract). Himmel is not concerned with providing frequently accessed domain names to a network gateway (i.e., domain name system caching). Instead, Himmel simply allows for accessing a URL referenced by a bookmark and determining whether the bookmark should be updated to reflect any changes. (Himmel, 18:31-52).

2. *Himmel does not disclose providing frequently accessed domain names for use in domain name system caching*

The Examiner equates the server 503 of Himmel with the network gateway of independent claims 1, 22, and 39 and the I/O controller 40 of Himmel with the

communication interface of independent claims 1, 22 and 39.¹ (Examiner's Answer, p. 14). Furthermore, the Examiner equates the bookmark entries of Himmel to the frequently accessed domain names of independent claims 1, 22, and 39. However, Himmel does not disclose "**providing** the frequently access domain names to the communication interface for transmission to the network gateway over a communication path," as recited in the claims, since the bookmark entries of Himmel are never provided to the I/O controller or server of Himmel.

As noted in the Examiner's cited section of Himmel, "the client 501 sends an **HTTP request** to old Web address listed in its bookmark set 502." (Himmel, 18:17-30). Nowhere does the client of Himmel "**provid[e]** the frequently accessed domain names ... for transmission to the network gateway." Instead, Himmel only initiates an HTTP request to an address which is listed in the bookmark set. Assuming, *arguendo*, that the address from the bookmark set is analogous to the frequently accessed domain names, which Appellant does not concede, the address is not "provid[ed] ... to the network gateway," but is instead used to determine **where to send** the HTTP request, the address corresponding to the server 503. Further assuming, *arguendo*, that the server of Himmel is analogous to the network gateway of independent claims 1, 22, and 39, Himmel does not teach, suggest, or disclose, "providing the frequently accessed domain names ... to the network gateway," and instead uses an alleged frequently accessed domain name to send an HTTP request to the corresponding

¹ The Examiner states, "Examiner interprets the I/O controller 40 is the communications interface and serves as an intermediary in the path to the network gateway (Figure 13: item 503)." (Examiner's Answer, p. 14). This position is internally inconsistent with positions adopted by the Examiner previously and throughout the Examiner's Answer. For example, the Examiner later "points out that the I/O controller per claim 10 functions as a network gateway." (Examiner's Answer, p. 20). For the sake of clarity, Appellant treats the Examiner's rejection consistently with the clarification of Examiner's Answer at page 14. Nevertheless, the rejection fails regardless of which component of Himmel is analogized to the network gateway of the claims.

server. The frequently accessed domain name is simply the target of the request. This functionality is completely different from independent claims 1, 22, and 39.

3. *The server of Himmel is not analogous to the network gateway of the claims*

Himmel nowhere teaches, suggests, or discloses, "the frequently accessed domain names to be provided to a network gateway *for use in domain name system caching*," as recited in independent claims 1 and 39. The Examiner argues that this recitation "has not been given patentable weight because the recitation occurs in the preamble." (Examiner's Answer, p. 13).

The Examiner fails to consider that claims 1 and 39 are written from the perspective of the customer premises equipment. In particular, the operation of "providing the frequently accessed domain names to the communication interface for transmission to the network gateway over a communication path" occurs in order for "the frequently accessed domain names to be provided to a network gateway for use in domain name system caching."

The preamble recites language which results in structural differences in the network gateway, thereby reciting a method within the customer premises equipment by which "the frequently accessed domain names [are] provided to a network gateway *for use in domain name system caching*." MPEP 2111.02 states, "statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use *results in a structural difference* ... between the claimed invention and the prior art." Here, it is clear that the language, "a network gateway for use in domain name system caching," as recited in claims 1 and 39 results in a structural difference, namely that the network gateway is configured to be used in domain name system caching.

The aforementioned structural difference is a difference between the claimed invention and Himmel. As noted above, the Examiner equates the server 503 of Himmel

with the network gateway of claims 1 and 39, and the I/O controller 40 of Himmel with the communication interface of claims 1 and 39. (Examiner's Answer, p. 14) It is clear that the "server 503" of Himmel, which receives the HTTP request, does not receive the HTTP request "for use in domain name system caching." In fact, the "server 503" of Himmel has no capability whatsoever to be "for use in domain name system caching," and therefore is not analogous to the network gateway of claim 1, when the structural differences of the preamble are properly considered.

4. *Himmel does not disclose searching e-mail application data files*

With further attention to claims 6, 26, and 41, Himmel nowhere teaches, suggests, or discloses, "wherein step (a) [searching files in memory] comprises searching application data files associated with an electronic mail application," as recited in claim 6, and the analogous claim language of claims 26 and 41. The Examiner does not properly address this point. The Examiner cites to the ability of Himmel to transmit a bookmark set via e-mail. (Himmel, 6:63-7:2). Transmitting a bookmark set is a completely different concept than "searching application data files associated with an electronic mail application," this searching "to identify frequently accessed domain names," as recited in independent claim 1, from which claim 6 depends. The Examiner then cites to Himmel's ability to search bookmark entries for a match with the current web site. (Himmel, 17:57-62). This has nothing to do with "searching application data files *associated with an electronic mail application*," and clearly cannot be used to teach, suggest, or disclose this feature.

5. *Conclusion*

Claims 2-9, 23-29, 40-45, 48, and 50 each depend from one of claims 1, 22, and 39, and are also not anticipated by Himmel for at least the same reasons as claims 1, 22, and 39, from which they depend, and further in view of their own respective features. Claims 6, 26, 41 are not anticipated by Himmel by the additional reasons provided in Section A4, above.

Accordingly, for at least the foregoing reasons, Appellant respectfully requests the reconsideration and reversal of the rejection of claims 1-9, 22-29, 39-45, 48, and 50 under 35 U.S.C. § 102(e).

B. Rejection of claims 10-21, 30-38, 46, 47, and 49 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,041,360 to Himmel et al. in view of U.S. Patent Application Publication No. 2002/0065936 to Schiuma.

The Examiner has maintained the rejection of claims 10-21, 30-38, 46, 47, and 49 under 35 U.S.C. § 103(a) as allegedly being obvious over Himmel in view of U.S. Application Publication No. 2002/0065936 to Schiuma ("Schiuma"). Appellant respectfully maintains the Appeal.

1. Schiuma does not supply the missing teaching or suggestion for "providing the frequently accessed domain name from the customer premises equipment to the network gateway"

Independent claim 10 recites, *inter alia*, "a network gateway that includes a cache," "providing the frequently accessed domain name from the customer premises equipment to the network gateway," and "storing the frequently accessed domain name and the corresponding IP address in the cache."

For the reasons previously noted with regard to independent claim 1, the "server 503" of Himmel is in no way analogous to the network gateway of claim 10. Nevertheless, the Examiner attempts to combine the browser cache of Schiuma with this server of Himmel to allegedly teach or suggest the features of claim 10. (Examiner's Answer, pp. 8-9).² The browser cache of Schiuma can arguably be combined with the client browser of Himmel or

² As noted in the previous footnote, the Examiner equates the gateway of claim 10 to the I/O controller of Himmel, which is internally inconsistent with the Examiner's own previous clarification. Nevertheless, the references do not teach or suggest "providing the frequently accessed domain name from the customer premises equipment to the network gateway," regardless of the component assumed to be analogous to the gateway.

the server of Himmel. However, both combinations fail to teach or suggest the claims invention.

First, the Examiner appears to argue to that the browser cache of Schiuma is combined with the browser of Himmel when he states that "it would [have] been obvious and yielded predictable results to implement a DNS cache in the browser of Himmel[.]" However, assuming the propriety of combining Himmel and Schiuma, which Appellant does not concede, the conventional browser cache of Schiuma, which simply caches sites it has accessed, still does not teach or suggest providing the frequently accessed domain name from the customer premises equipment (or browser cache of Schiuma) to the network gateway (or server of Himmel), and then "storing the frequently accessed domain name and the corresponding IP address in the cache," as recited in claim 10. In short, Schiuma fails to send stored domain names to a network gateway.

Second, combining the browser cache of Schiuma with the server of Himmel also fails since any domain names in the browser cache of Shiuma were not provided from the client browser of Himmel. Nor is there any suggestion to provide domain names to the server of Himmel. In short, neither reference provides any manner of teaching or suggestion which would enable one of ordinary skill in the art to implement a domain name system cache at a network gateway, and moreover to provide frequently access domain names from a customer premises equipment to this network gateway for caching.

2. *The Examiner's argument that Himmel itself teaches or suggests a network gateway including a cache in claim 30 is unsupported*

In regard to independent claim 30, the Examiner appears to argue that "a network gateway *including a cache*" used "to store the frequently accessed domain name and the corresponding IP address in the cache," is actually taught or suggested entirely by Himmel. Appellant strongly disagrees. (Examiner's Answer, p. 11).

The Examiner cites to a section of Himmel as allegedly teaching or suggesting a cache. However, the cache taught by Himmel simply discloses storing "pointers to cached copies of the web page [which] can be included in the bookmark entry." (Himmel, 6:26-28). The location of the cached copies themselves is unspecified in Himmel, and there is no teaching or suggestion whatsoever that they would be present at a "network gateway," as recited in claim 30.

Moreover, the cache of Himmel is clearly to store "cached copies of the web page." (Himmel, 6:26-28). This is completely different than the use of the cache of claim 30, which is "to store the frequently accessed domain name and the corresponding IP address in the cache." Accordingly, Himmel does not teach or suggest "a network gateway including a cache," as recited in claim 30.

3. Conclusion

Therefore, neither Himmel nor Schiuma teaches or suggests "providing the frequently accessed domain name from the customer premises equipment to a network" and "storing the frequently accessed domain name and the corresponding IP address in the cache," as recited in claim 10, nor the analogous features, using respective language, of claims 21 and 30, and therefore does not render those claims obvious. Claims 11-20, 31-38, 46, 47, and 49 each depend from one of claims 10, 21, and 30, and are also not rendered obvious by the combination of Himmel and Schiuma for at least the same reasons as claims 10, 21, and 30, and further in view of their own respective features.

Accordingly, Appellant respectfully requests the reconsideration and reversal of the rejection of claims 10-21, 30-38, 46, 47, and 49 under 35 U.S.C. § 103(a).

C. Conclusion

The subject matter of claims 1-50 is patentable over the cited prior art because the Examiner has failed to make a prima facie case of anticipation or obviousness. Therefore, Appellant respectfully requests that the Board reverse the Examiner's final rejection of these claims under 35 U.S.C. §§ 102 and 103 and remand this application for issue.

Respectfully submitted,

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